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NO. 490 P. 2



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,060	08/03/2001	Deepak Pai	10001-20420 02708-0047-NF0500	7591
2574 7590 04/22/2004 JENNER & BLOCK, LLC ONE IBM PLAZA CHICAGO, IL 60611			EXAMINER MAYEKAR, KISHOR	
			ART UNIT 1753	PAPER NUMBER

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DEC 14 2004

JENNER & BLOCK LLP

**Office Action Summary****Application No.**

09/922,060

**Applicant(s)**

PAI, DEEPAK

**Examiner**

Kishor Mayekar

**Art Unit**

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-57 is/are pending in the application.
- 4a) Of the above claim(s) 37-57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-34 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

Application/Control Number: 09/922,060  
Art Unit: 1753

Page 2

## DETAILED ACTION

### *Election/Restrictions*

1. Newly submitted claims 37-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: new claims 37-48 (second invention) drawn to an HVAC system, claims 49-53 (third invention) drawn to a building and claims 54-57 (fourth invention) drawn to an apparatus configured to neutralize harmful agents which all are independent and distinct from original claims 1-11 and 12-36 (first invention) drawn to a dielectric barrier discharge system as they are different in effect (in accord with Applicant's remark that the cited prior art in the last Office being non-analogous art to new claims 37-57); the second invention with a safety system, the third invention with a control system and the fourth invention with a mobile cart.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Application/Control Number: 09/922,060  
Art Unit: 1753

Page 3

***Claim Rejections - 35 USC § 102 and § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 11, 29 and 36 stand rejected under 35 U.S.C. 102(e) as being clearly anticipated by HEMINGWAY et al. (6,464,945), for reasons as of record.

4. Claims 18, 19 and 26-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over HEMINGWAY '945, for reasons as of record.

5. Claims 4-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over HEMINGWAY '945 in view of KIERSER et al. (5,746,051), for reasons as of record.

6. Claims 4-10 and 13-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over HEMINGWAY '945 in view of LIOU (6,007,785) and RACCA et al. (6,024,930), for reasons as of record.

Application/Control Number: 09/922,060  
Art Unit: 1753

Page 4

7. Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over HEMINGWAY '945 in view of SLIPIEC et al. (3,967,131), for reasons as of record.

8. Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over HEMINGWAY '945 in view of BIRMINGHAM et al. (4,954,320), for reasons as of record.

***Allowable Subject Matter***

9. Claim 35 stands allowed, for reasons as of record.

***Response to Arguments***

10. Applicant's arguments filed 21 September 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that HEMINGWAY fails to disclose, teach, or suggest a protective layer covering the recited conductive coating, HEMINGWAY does teach a dielectric barrier discharge plasma cell comprising all the structures as claimed as asserted by the examiner in the last Office action with

Application/Control Number: 09/922,060  
Art Unit: 1753

Page 5

- a conductor 38; and
- dielectric spaced apart from the conductor 38, comprising
  - a dielectric substrate 28 having a first surface nearer to the conductor 38 and a second surface, opposite the first surface and farther away from the conductor 38;
  - a conductive coating 26 on the second surface; and
  - a protective coating 34 covering the conductive coating 26.

Since HEWINGWAY teaches the plasma cell comprises all the structures as claimed, it anticipates claims 1, 2 11, 29 and 36.

As to the rejections of other claims 3-10, 13-28 and 30-35, the rejections are maintained.

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the

Application/Control Number: 09/922,060  
Art Unit: 1753

Page 6

advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

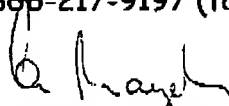
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

Application/Control Number: 09/922,060  
Art Unit: 1753

Page 7

only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kishor Mayekar  
Primary Examiner  
Art Unit 1753